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09/884,921	06/21/2001	Márco Peretti	702265.0007	6896

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EXAMINER

REVÁK, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/884,921

Applicant(s)

PERETTI, MARCO

Examiner

Christopher A. Revak

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-30 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7,21,29, and 30 contain the trademark "Windows", "Windows NT" and "Windows 2000". Where a trademark is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark cannot be used properly to identify any particular material or product. A trademark is used to identify a source of goods, and not the goods themselves. Thus, a trademark does not identify or describe the goods associated with the trademark. In the present case, the trademark is used to identify software and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-14 and 16-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Bharat, U.S. Patent 6,577,735.

As per claims 1, 18, and 22, Bharat discloses of a method, apparatus, and computer readable medium containing embedded software for backing up (shadowing) only accesses to audio data stored on a portable audio player comprising a compact disk (external storage media)(col. 3, lines 47-53 and col. 4, lines 25-28). Input/Output access is detected to the compact disk (external storage medium). A copy of the accessed data is written onto the computer's hard disk (location other than the external storage medium)(col. 3, lines 47-55).

As per claims 2 and 19, it is taught by Bharat of access being a write operation (col. 5, lines 22-25).

As per claim 3, Bharat discloses of accessing being a read operation (col. 5, lines 22-25).

As per claims 4 and 20, Bharat teaches of intercepting the I/O request from the computer to the compact disk (external storage medium) drive in which the compact disk (external storage medium) is inserted to check for authenticity (col. 7, lines 48-60).

As per claim 5, Bharat discloses of the I/O request includes both read and write requests (col. 5, lines 22-25).

As per claims 6 and 23, it is taught by Bharat of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 31-34 and col. 7, lines 55-60).

As per claims 7,21,24, and 25, the teachings of Bharat disclose of use of an operating system stored in the system memory (col. 4, lines 27-30). It is interpreted by the examiner that the operating system can be instructed to perform commands such as IRP\_MJ\_READ and IRP\_MJ\_WRITE since they vary depending upon how the developer identified the code to be executed. Bharat does disclose of both read and write operations (col. 5, lines 22-25).

As per claim 8, Bharat discloses of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 31-34 and col. 7, lines 55-60). It is interpreted by the examiner that the operating system can be instructed to perform commands such as IRP\_MJ\_READ and IRP\_MJ\_WRITE since they vary depending upon how the developer identified the code to be executed. Bharat does disclose of both read and write operations (col. 5, lines 22-25).

As per claim 9, the teachings of Bharat disclose of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 31-34 and col. 7, lines 55-60). It is interpreted by the examiner that the operating system can be instructed to perform a command such as IRP\_MJ\_READ since they vary depending upon how the developer identified the code to be executed. Bharat discloses read operations (col. 5, lines 22-25).

As per claim 10, Bharat teaches that the data stored on the computer's hard disk (location other than the external storage medium) is stored as an encrypted file (protected storage location)(col. 3, lines 47-54).

As per claim 11, Bharat discloses of writing the data to the portable jukebox (comprising an external storage medium) after the step of writing a copy of the data to the computer's hard disk (location other than the external storage medium)(col. 3, lines 47-55 and col. 8, lines 4-24).

As per claim 12, it is taught by Bharat of attaching file systems connected to an external storage medium drive in which the external storage medium is connected and intercepting the I/O request from the computer to the compact disk (external storage medium) drive in which the compact disk (external storage medium) is inserted to check for authenticity (col. 7, lines 48-60).

As per claim 13, it is disclosed by Bharat that the external storage medium is a compact disk (col. 3, lines 51-53).

As per claim 14, the teachings of Bharat disclose of storing the accessed data onto the computer's hard disk (database)(col. 3, lines 47-55). It is interpreted by the examiner that this information can be queried since it contains similar copies.

As per claim 16, Bharat discloses of the computer is connected to a computer network and the detecting and copying is performed at the computer (col. 3, lines 47-55 and col. 4, lines 19-22). Collecting and querying is performed using the CDDb at another computer on the network (col. 4, lines 19-22 and col. 5, lines 43-46).

As per claim 17, Bharat teaches of collecting and querying is performed by a user who is authorized (with administrator privileges)(col. 6, lines 57-61).

As per claim 26, Bharat discloses of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 31-34 and col. 7, lines 55-60). File identifiers are stored in a list (col. 3, lines 1-8).

As per claim 27, Bharat discloses that the file identifiers are serial numbers (IRP.FsContext values)(col. 3, lines 1-8).

As per claim 28, Bharat discloses of a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive. The number of iterations (certain file operations) is counted in determining authenticity of the compact disk (external storage medium) after failing to do so (col. 4, lines 31-34 and col. 7, lines 55-60).

As per claim 29, Bharat discloses of the computer running an operating system and that includes a file handling system (proxy handler) for the I/O requests and executing it in response to detection of media in the drive (col. 4, lines 25-34 and col. 7, lines 55-60).

As per claim 30, it is taught by Bharat that an operating system (Windows NT) is stored in the system memory (col. 4, lines 27-30).

***Allowable Subject Matter***

6. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ji et al, U.S. Patent 6,836,657 discloses of generating backup copies of updated files.

Swamy et al, U.S. Patent 5,935,244 discloses of a applying security for detachable I/O device connected to a computer.

SecureNT Overview discloses of I/O devices are applied access control lists.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CR  


March 13, 2005

Christopher Revak

AU 2131



3/13/05